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| APPLICATION NO.                                                                                                                                   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO.       |
|---------------------------------------------------------------------------------------------------------------------------------------------------|-------------|----------------------|------------------------------|------------------------|
| 10/751,006                                                                                                                                        | 12/31/2003  | Matthew F. Kelly     | BLLYP032.US02                | 5521                   |
| 45965 7590 10/16/2007<br>TECHNOLOGY & INTELLECTUAL PROPERTY<br>STRATEGIES GROUP PC (dba TIPS GROUP)<br>P. O. BOX 1639<br>LOS ALTOS, CA 94023-1639 |             |                      | EXAMINER<br>MOSSER, ROBERT E |                        |
|                                                                                                                                                   |             |                      | ART UNIT<br>3714             | PAPER NUMBER           |
|                                                                                                                                                   |             |                      | MAIL DATE<br>10/16/2007      | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/751,006

Applicant(s)

KELLY ET AL.

Examiner

Robert Mosser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 7/11/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Claim number 7 is absent from the amended claims presented March 8<sup>th</sup>, 2004, and is considered cancelled.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

*[The remarks section as presented below is incorporated herein by reference]*

Claims 1-4, 9-11, 14, 18-19, and 27-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Wendkos (US 5,983,196).

Claims 1-3: Wendkos teaches an interactive computer network including:

allowing a participant to participate in a game on multiple occasions and thereby providing a plurality of games in exchange for a monetary commitment (Col 16:66-17:2);

based on the participant's interaction with the game awarding the player a prize (Col 16:58-64), wherein said prize includes prize credits and a merchandise prizes (Figure 5);

and allowing the player to redeem their prize credits through displaying information from a website corresponding to a plurality of centralized servers (interactive platform) that regulate prize distribution on the game unit where the prizes are won (Col 16:63-66).

Wherein the Internet is inherently composed of a plurality of interconnected servers. In combination with the teachings of Wendkos the Internet provides for an interactive computing platform utilized to manage and regulate prize distribution.

Claims **4, 9, and 27**: Wendkos teaches allowing a user accrue (Abstract) and redeem their prize as long distance time at a remote telephone (Col 2:46-60).

Claims **10-11**: Wendkos teaches the manual entry of player address information (Col 3:43-52, Figure 4, 25B).

Claims **14, and 18-19**: Wendkos teaches the redemption credits at the device where the credits were acquired (Col 14:61-15:9).

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Claims **28-29**: Wendkos further teaches that the disclosed system is customizable by the operator through selective activation of features (Col 8:57-65) and control over payout features (Col 11:23-29).

Claim **30**: Wendkos teaches providing a list of customers who have redeemed certificates to the sponsors (Col 10:34-44).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **5-6**, and **8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wendkos (US 5,983,196).

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Claim 5: Wendkos teaches the network computing arrangement including the use of the internet as taught above however is silent regarding allowing players to utilize multiple web pages from where the prize was won to display information relating to prize redemption on the internet. The examiner gives official notice that the use of webpage to display information from the Internet on a client computer is extremely old and well known in the art. As the invention of Wendkos is silent regarding the specific manner utilized in the communication of information over the Internet one of ordinary skill at the time of invention would have been motivated to use the known manner of Internet web page communication to realize the invention of Wendkos. It therefore would have been obvious to one of ordinary skill in the art at the time of invention to have utilized web pages to display the prize information in the internet connected computing system of Wendkos to employ conventional and proven technology to provide players with formatted prize information.

Claims 6, and 8: Wendkos teaches the network computing arrangement including the use of the internet as taught above however is silent regarding the particular web page technologies utilized to construct web pages. The Examiner gives official notice that the utilization of HTML standard and Java script are exceptional old and well known technologies for the creation of web pages. As the invention of Wendkos is silent regarding the particular web page technologies utilized to construct web pages one of ordinary skill at the time of invention would have been motivated to use known manners of Internet communication to realize the invention of Wendkos. It therefore would have

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been obvious to one of ordinary skill in the art at the time of invention to have utilized html standard and Java script in the creation of web pages in the internet connected computing system of Wendkos to employ common standards and scripts available at the time of claimed invention.

Claims **23-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wendkos (US 5,983,196) as applied to at least claim **2** above and further in view of Schneier et al (5,768,382).

Wendkos teaches the network computing arrangement including the identification of a player as taught above and the inclusion of football type games however Wendkos is silent on whether or not the disclosed football game is a game of chance or skill. As the invention of Wendkos is silent on whether or not the disclosed football game is a game of chance or skill one of ordinary skill at the time of invention would have been motivated to seek other teachings on game types related to football. Schneider et al includes teachings directed to a football type games (Col 36:26-53) and additional teachings that such games played over a remote terminal may be of a chance or skill type game (Col 9:12-15, 7:8-14, 48:42-53). It therefore would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the football game of Wendkos as a chance or skill game in order to employ known conventional gaming types in a football related games as taught by Schneier et al.

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Claims **12** and **13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wendkos (US 5,983,196) as applied to at least claim **2** above and further in view of Atkins (5,644,727).

Wendkos teaches the network computing arrangement including the identification of a player and player address as taught above however is silent regarding the automatic extracting of known information from a credit card. In a related account management system Atkins teaches automatic extracting of customer supplied information from a credit card in order to verify the identity of an individual. It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated automatic extracting of customer supplied address information from a credit card in order to verify the identity of an individual as taught by Atkins (Atkins Col 5:62-65).

Claims **15-17** and **20-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wendkos (US 5,983,196) as applied to at least claim **2** above and further in view of Cohen et al (US 5,231,568).

Wendkos teaches the network computing arrangement including the identification of a player and player address as taught above however is silent regarding allowing the redemption of prizes through the printing of coupons containing barcodes. In a related invention however Cohen et al teach the presentation of coupons for the delivery of prizes (*Cohen* Col 3:19-25), that may exchanged at a retail facility (Col 7:51-66). The Examiner gives *official notice* that it is old and well known in the art of tickets and



coupons to utilize printed barcodes on the printed device for ease of entry and record keeping. It would have been obvious to one of ordinary skill in the art at the time of invention to have utilized the coupon reward features of Cohen et al in the invention of Wendkos with the inclusion of barcodes to reduce cost of prize delivery in a manner that is machine readable and convenient for the tracking of said coupons.

### ***Response to Arguments***

Applicant's arguments filed July 16<sup>th</sup>, 2007 have been fully considered but they are not persuasive.

The Applicant is reminded that claims are rejected under prior references in their entirety and not prior art citations. In the presented arguments the Applicant appears to be attempting to demonstrate a proposed delineation between their claimed invention and the teachings of Wendkos premised on partial citations rather than the reference as a whole.

On page number 3 of the Applicant's remarks submitted July 16<sup>th</sup>, 2007, the Applicant suggests that Wendkos reference teaches a purchasable game rather than a pay per use environment. The Applicant's claim language simply does not preclude the purchase of a game or alternatively stated limit the claimed invention to a pay per use model.

On pages number 3 through 4 of the Applicant's remarks submitted July 16<sup>th</sup>, 2007, the Applicant suggests that the rejection of record does not clearly point out the claimed prize selection mechanism associated with the redemption system. The

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rejection as previously presented sets forth "...and allowing the player to redeem their prize credits through displaying information from a website corresponding to a plurality of centralized servers (interactive platform) that regulate prize distribution on the game unit where the prizes are won; " (see page 3 of the office action mailed January 11<sup>th</sup>, 2007). Further teachings on this topic are presented by Wendkos in at least column 14 lines 49-66 and figures 21-22.

Applicant continues to argue the above citation as not clearly providing for "displaying information from websites". In addition to the citations presented above wherein Wendkos sets forth the realization of the prize distribution system including servers over a network, Wendkos additionally sets forth that the disclosed network can be an Internet type network (Col 6:43-47). Hence Wendkos teaches providing a plurality of servers in communication over an Internet network to provide interactive features to a user/player. This configuration of Wendkos defines and therefore is equated to a website. Arguments presented regarding this feature absent any further defining criteria of a website are presently not supported.

Applicant argues several points of proposed novelty on pages 4 and 5 of their remarks submitted July 16<sup>th</sup>, 2007, premised on the prior art of Wendkos only the awarding of telephone time as a redeemable prize however as Wendkos does not limit the invention to telephone time but includes additional prizes this argument is in error (Col 15:10-22).

The Applicant suggests that the Examiner attempts to employ official notice (implicitly) that the internet is composed of a plurality of servers interconnected with an

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interactive computer platform utilized to manage and regulate prize distribution. Why the original statement contained a typographical error, the intended and now presented clarification recites the a position of inherency that the internet is composed of a plurality of servers. As evidence of the inherency of this feature a copy an article entitled 'How Internet Infrastructure Works" by Jeff Tyson has been attached. In the interest of further clarification this article has been attached as evidence of the inherency and not as a grounds of rejection.

The Applicant challenge of Official Notice is improper, To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/RM/  
October 10<sup>th</sup>, 2007

  
ROBERT E. PEZZUTO  
SUPERVISORY PRIMARY EXAMINER